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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,932	03/22/2004	Michael K. Brown	555255012483	1029
7590 John V. Biernacki, Esq. Jones Day 901 Lakeside Avenue/North Point Cleveland, OH 44114		12/23/2008	EXAMINER AJAYI, JOEL	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 12/23/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/805,932	BROWN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JOEL AJAYI	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 15 September 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-12, 14-23 and 25-30 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-12, 14-23, 25-30 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 2, 5-12, 14-23, 25-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bouchard (U.S. Patent Application Number: 2003/0115448)** in view of **Picoult et al. (U.S. Patent Application Number: 2002/0065042)**, and further in view of **Brooks (U.S. Patent Application Number: 2004/0117456)**.

Consider **claim 1**; Bouchard discloses a method for handling secure message attachments for a mobile device, comprising the acts:

Receiving at a server (the master server sends the second attachment to the satellite server) second attachment provided within a secure message (paragraphs 56 and 58); wherein the secure message itself was received by the server as a first attachment (second encrypted email) (paragraph 62, lines 4-20); processing at the server the secure message in order to locate within the secure message the second attachment (first encrypted email) (paragraph 62, lines 4-20); and providing the second attachment to the mobile device (paragraph 63, line 1) (even though a desktop is used in this example, the client device can be a wireless device, paragraph 30, lines 1-8).

Except: requesting the second attachment from the mobile device.

In an analogous art, Picoult discloses requesting any attachments from the mobile device (paragraph 31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Bouchard by including the means for a mobile device to access information, as taught by Picoult, for the purpose of receiving messages with ease and flexibility.

Bouchard and Picoult disclose the claimed invention except: providing the secure message without the second attachment to the device.

In an analogous art Brooks discloses providing the secure message without the second attachment to the device (paragraphs 46 and 48, lines 1-22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Bouchard and Picoult by including a secure message without an attachment as taught by Brooks for the purpose of securely transmitting attachments in a network.

Consider **claim 2**; Bouchard discloses that the secure message is structured according to a security scheme such that the secure message is handled as an attachment by the server (paragraphs 56 and 58).

Consider **claim 5**; Bouchard discloses that the security scheme is a Secure Multipurpose Internet Mail Extensions (S/MIME) scheme (paragraph 58).

Consider **claim 6**; Bouchard discloses that the secure message is structured such that a secure layer has been added to the message and the second attachment (paragraphs 56 and 58).

Consider **claim 7**; Bouchard discloses that the secure layer acts as an envelope with respect to the message and the second attachment (paragraphs 56, 58, 62).

Consider **claims 8, 11**; Bouchard discloses that the secure layer was generated during an encryption operation (paragraphs 56 and 58).

Consider **claim 9**; Bouchard discloses that a session key is received by the server from the mobile device for use by the server to decrypt the secure message (the public key is available to both the server and mobile device. Even though a desktop is used in this example, the client device can be a wireless device, paragraph 30, lines 1-8) (paragraph 62 and 63).

Consider **claim 10**; Bouchard discloses that the secure layer was generated during a digital signature operation (paragraph 58).

Consider **claim 12**; Picoult discloses that the second attachment is selected from the group consisting of: a textual document, word processing document, audio file, image file, and video file (paragraph 25, lines 8-17; paragraph 31).

Consider **claim 14**; Picoult discloses that the request from the mobile device for the second attachment results from a user request about the second attachment (paragraph 31).

Consider **claim 15**; Brooks discloses that the request from the mobile device includes data to be used by the server to identify the second attachment that is to be provided to the mobile device (paragraphs 46 and 48, lines 1-22).

Consider **claim 16**; Brooks discloses that the secure message is structured such that a secure layer has been added to the message and the second attachment, wherein the secure layer was generated during an encryption operation, wherein a decryption operation is performed in order to locate within the secure message the second attachment (paragraphs 46 and 48, lines 1-22).

Consider **claim 17**; Bouchard discloses that the secure message has a plurality of attachments (paragraph 56).

Consider **claim 18**; Brooks discloses that the server provides an indication to the mobile device that the secure message has the second attachment, wherein the indication is used by the mobile device to provide a user indication that the secure message has the second attachment (paragraphs 46 and 48, lines 1-22).

Consider **claim 19**; Brooks discloses that the second attachment is automatically provided by the server to the mobile device when the secure message is opened in response to a user request (paragraphs 46 and 48, lines 1-22).

Consider **claims 20**; Bouchard discloses that the second attachment is rendered before being provided to the mobile device (the message is processed) (paragraph 62).

Consider **claim 21**; Bouchard discloses a means for providing a wireless network and means for providing a message server are used to communicate the located attachment to the mobile device (paragraphs 29 and 62).

Consider **claims 22, 23, 25**; Bouchard discloses that the mobile device is a handheld wireless mobile communications device (paragraph 30, lines 1-8).

Consider **claim 26**; Bouchard discloses an apparatus located at a computer server for handling secure message attachments for a mobile device, wherein the server receives a secure message containing a second attachment (paragraphs 56 and 58), comprising:

the secure message contains a secure layer such that the secure message itself is received by the server as a first attachment (second encrypted email) (paragraph 62, lines 4-20); a secure message processing module that looks into the secure message through the secure layer in order

to locate the second attachment (first encrypted email) (paragraph 62, lines 4-20); wherein the second attachment is provided to the mobile device (paragraph 63, line 1) (even though a desktop is used in this example, the client device can be a wireless device, paragraph 30, lines 1-8).

Except: a data store that stores the secure message and the second attachment.

In an analogous art, Picoult discloses that the server stores the secure message and any attachments (paragraph 25, lines 8-17; paragraph 31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Bouchard by including the means for a mobile device to access information, as taught by Picoult, for the purpose of receiving messages with ease and flexibility.

Bouchard and Picoult disclose the claimed invention except: providing the secure message without the second attachment to the device; after the server receives a request for the second attachment from the device.

In an analogous art Brooks discloses providing the secure message without the second attachment to the device (paragraphs 46 and 48, lines 1-22); after the server receives a request for the second attachment from the device (paragraphs 46 and 48, lines 1-22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Bouchard and Picoult by including a secure message without an attachment as taught by Brooks for the purpose of securely transmitting attachments in a network.

Consider **claim 27**; Bouchard discloses rendering the second attachment before the second attachment is provided to the mobile device (paragraph 62).

Consider **claim 28**; Bouchard discloses a decryption processing module to decrypt the secure message so that the second attachment can be located within the secure message (paragraph 62).

**Claims 3 and 4** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bouchard (U.S. Patent Application Number: 2003/0115448)** in view of **Picoult et al. (U.S. Patent Application Number: 2002/0065042)**, in view of **Brooks (U.S. Patent Application Number: 2004/0117456)**, and further in view of **Kiessling et al. (U.S. Patent Number: 6,795,924)**.

Consider **claims 3 and 4**; Bouchard and Picoult disclose the claimed invention except that the security scheme includes a symmetric and asymmetric key scheme.

In an analogous art, Kiessling discloses that the security scheme includes a symmetric and asymmetric key scheme (column 2, lines 12-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Bouchard and Picoult by including symmetric and asymmetric methods, as taught by Kiessling, for the purpose of providing secure messages to mobile terminals.

**Claims 29 and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bouchard (U.S. Patent Application Number: 2003/0115448)** in view of **Brooks (U.S. Patent Application Number: 2004/0117456)**.

Consider **claim 29**; Bouchard discloses an apparatus located at a computer server for handling secure message attachments for a mobile device, comprising:

means for receiving a second attachment (first encrypted email) provided with a secure message (paragraphs 56, 58, 62, lines 4-20); wherein the secure message itself was received by the server (satellite server) as a first attachment (second encrypted email) (paragraph 62, lines 4-20); means for processing (decrypt and extract) the secure message in order to locate within the secure message the second attachment (paragraph 62, lines 4-20); means for providing the second attachment to the mobile device (paragraph 63, line 1) (even though a desktop is used in this example, the client device can be a wireless device, paragraph 30, lines 1-8).

Except: providing the secure message without the second attachment to the device; receiving a request for the second attachment from the device.

In an analogous art Brooks discloses providing the secure message without the second attachment to the device (paragraphs 46 and 48, lines 1-22); receiving a request for the second attachment from the device (paragraphs 46 and 48, lines 1-22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Bouchard by including a secure message without an attachment as taught by Brooks for the purpose of securely transmitting attachments in a network.

Consider **claim 30**; Bouchard discloses rendering the second attachment before the second attachment is provided to the mobile device (paragraph 62); a decryption processing module to decrypt the secure message so that the second attachment can be located within the secure message (paragraph 62).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Joel Ajayi whose telephone number is (571) 270-1091. The Examiner can normally be reached on Monday-Thursday from 7:30am to 5:00pm and Friday 7:30am to 4:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lester Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

*Joel Ajayi*

/Lester Kincaid/  
Supervisory Patent Examiner, Art Unit 2617